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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/668,267	09/24/2003	Gordon F. Bosley	2147-002	4783

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EXAMINER

WALKER, ZAKIYA NICOLE

ART UNIT	PAPER NUMBER
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3672

DATE MAILED: 05/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/668,267

Applicant(s)

BOSLEY, GORDON F.

Examiner

Zakiya N. Walker

Art Unit

3672

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-22 is/are pending in the application.
4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 14-16, 19 and 20 is/are rejected.
- 7) ☒ Claim(s) 17, 18, 21 and 22 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 02132004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: page 1, the cross-reference to related applications section should be updated to include the U.S. Patent No. 6,705,404.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claim 14 is rejected under 35 U.S.C. 102(b) as being anticipated by Swihart, Sr. (cited by applicant) or Peters.

Swihart, Sr. discloses an apparatus that includes a valve for enhancing the production of gas from a tubing string extending down a wellbore to a reservoir having diminished pressure, the wellbore having an isolated annulus charged with a continuous flow of high pressure gas and a plunger lift system, the valve comprising: a tubular housing 12 having a bore, the housing being connected to the tubing string and having an upper production port 34 fluidly connected to the tubing string above the valve, a lower production port 30 fluidly connected to the reservoir below the valve and an unloading port 27 fluidly connecting the isolated annulus to the tubing string above the

valve; and a valve stem 56 having an uphole 54 and a downhole 66 piston, housed within the valve housing and axially moveable therein between a first uphole production position wherein the uphole piston 54 blocks the unloading port, the upper and lower production ports are fluidly connected and the downhole piston 66 opens the reservoir to the lower production port, and a second downhole lift position wherein the downhole piston blocks the reservoir from the lower production port and the uphole piston opens the unloading port.

Peters discloses an apparatus that includes a valve for enhancing the production of gas from a tubing string extending down a wellbore to a reservoir having diminished pressure, the wellbore having an isolated annulus charged with a continuous flow of high pressure gas and a plunger lift system, the valve comprising: a tubular housing 40 having a bore, the housing being connected to the tubing string and having an upper production port 54, 56 fluidly connected to the tubing string above the valve, a lower production port 100 fluidly connected to the reservoir below the valve and an unloading port 58 fluidly connecting the isolated annulus to the tubing string above the valve; and a valve stem having an uphole and a downhole piston, housed within the valve housing and axially moveable therein between a first uphole production position wherein the uphole piston 104 blocks the unloading port, the upper and lower production ports are fluidly connected and the downhole 62 piston opens the reservoir to the lower production port, and a second downhole lift position wherein the downhole piston blocks the reservoir from the lower production port and the uphole piston opens the unloading port.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 14-16, 19, and 20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 3-5, 6, and 8 of U.S. Patent No. 6,705,404. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the instant invention are broader in scope than the claims of the '404 patent. It would be considered obvious that claims 14-16, 19, and 20 of the instant invention do not preclude the presence of the additional elements found in claims 3-5, 6, and 8 of the '404 patent.

Allowable Subject Matter

6. Claims 17, 18, 21, and 22 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Mayfield et al. teaches an apparatus that includes a plunger valve having a housing, ports, and valve stem.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zakiya N. Walker whose telephone number is (703) 305-0302. The examiner can normally be reached on Tuesday-Friday, 6:30 AM-5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bagnell can be reached on (703) 308-2151. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Zakiya N. Walker
Primary Examiner
Art Unit 3672

zw
May 14, 2004